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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,918	11/06/2003	Her-Shang Chen	112.P14282	2917
43831 7590 04/11/2007 BERKELEY LAW & TECHNOLOGY GROUP, LLP 1700 NW 167TH PLACE SUITE 240 BEAVERTON, OR 97006			EXAMINER LAMB, CHRISTOPHER RAY	
			ART UNIT 2627	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/605,918	Applicant(s) CHEN ET AL.	
	Examiner Christopher R. Lamb	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892). | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Taiwan on November 3rd, 2003. It is noted, however, that applicant has not filed a certified copy of the 92127383 application as required by 35 U.S.C. 119(b).

Applicant indicated in their remarks filed January 24th, 2007, that a certified copy will be submitted after its receipt by the Assignee. It has not been filed as of the date of this Office Action.

Claim Objections

2. Claim 1 objected to because of the following informalities: in line 1, "an device" should be "a device." Appropriate correction is required.

3. Claim 28 objected to because of the following informalities: "plurality light beams" should be "plurality of light beams." Appropriate correction is required.

4. Claim 37 objected to because of the following informalities: in line 6, "final light source" should be "the final light source." Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 13, 16-18, 29, 30, and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

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contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1:

It claims first "projecting one or more first light beams from the final light source outward" and then "dividing the one or more first light beams into one or more equidistant second light beams."

The specification, as originally filed, describes two situations:

(A) In one embodiment, as in Fig. 4, there is a plurality of final light sources projecting more than one light beams outward. However, these light beams are not then divided into one or more equidistant second light beams; they begin as equidistant light beams.

(B) In another embodiment, as in Fig. 8, there is a single final light source. The light from this source is divided into more than one equidistant light beams.

There does not appear to be any embodiment that discloses a plurality of original light beams that are then divided into a second plurality of light beams.

Thus the subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, is projecting more than one first light beams into a wave-distance-dividing module that divides the more than one first light beams into one or more equidistance second light beams.

Regarding claims 2-11:

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They are dependent on claim 1.

Regarding claim 13:

This is similar to claim 1 in that it claims dividing a "first plurality of light beams into a second plurality of light beams." This was not disclosed in the specification at the time the application was filed, and so this claim is likewise rejected.

Regarding claims 16-18:

They are dependent on claim 1.

Regarding claim 29:

Again, this claims "dividing the first plurality of light beams into a second plurality of light beams," and so is rejected for reasons similar to claim 1.

Regarding claim 30:

It is dependent on claim 29.

Regarding claim 38:

It claims "means for dividing the first plurality of light beams into a second plurality of light beams." No such means was disclosed at the time the application was filed, and so this claim is similarly rejected.

Regarding claims 39-41:

These claims are dependent on claim 38.

7. Claims 1-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1:

The “wave-distance-dividing module” recited in the claim is not described in the specification in such a way as to enable one skilled in the art to make it without undue experimentation.

The module is mentioned in, for example, paragraphs 29, 30, and 41 of the specification. However, only its function is described: no details whatsoever have been provided on how it works, what it is made from, or even what it looks like, as the figure illustrating it (Fig. 8) lacks detail.

In deciding that the wave-distance-dividing module cannot be made without undue experimentation, the Examiner has weighed a number of factors, but put particular emphasis on the following:

(A) The nature of the invention:

The invention is directed to simultaneous multi-beam, multi-track reading of an optical disc.

The purpose of the wave-distance-dividing module is to divide the beam from the first source into multiple beams spaced $0.74\text{ }\mu\text{m}$ apart, and to divide the beam from the second source into multiple beams spaced $1.6\text{ }\mu\text{m}$ apart.

This is crucial to the invention as a whole, because the invention is able to switch between two different sorts of optical discs. If the spacing can't be adjusted, the

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invention would be unable to read from one or the other of the discs, and thus there would be no point in the claimed "light-switching module" either.

(B) The state of the prior art:

Although the prior art does disclose reading from the same two kinds of discs, none of the prior art of record discloses a single module with this function. For example, the closest prior art, Kosoburd et al. (US 2003/0206503), requires two separate wave-distance-dividing modules (Fig. 1: 13 and 14), one for each source. In the specific field of multi-beam, multi-track reading, modules such as the one claimed do not appear to be common practice.

(C) The amount of direction provided by the inventor:

The inventor has provided no direction. As noted above, only the module's function has been described in the specification, not its makeup, and the module has not been depicted in any detail in any drawings.

(D) The existence of working examples:

The inventor has provided no working examples.

(E) The quantity of experimentation needed to make the invention:

One skilled in the art would need to start from scratch to make this module, as the Applicant has provided no indication as to where to begin. This is not a simple case of adjusting a few parameters or performing a few experiments: one attempting to make the invention would essentially need to re-invent the invention from the beginning.

Therefore, one skilled in the art would be unable to make the invention without undue experimentation.

Regarding claims 2-11:

As they are dependent on claim 1, they also contain the wave-distance-dividing module, and are likewise rejected.

Regarding claim 12:

This claim does not directly recite the “wave-distance-dividing module.” Furthermore, it is not clear what Applicant is trying to claim: see the 35 USC 112, second paragraph, rejection that follows.

For the purposes of this rejection, the Examiner has presumed that by “distancing the selected final light source into light beams,” Applicant is attempting to claim “dividing the light from the selected final light source into light beams.”

The specification only discloses one means for dividing the light from a light source into multiple light beams. That is the wave-distance-dividing module.

The specification does disclose another embodiment that has multiple light sources (see, for example, Fig. 4), but in this embodiment a light source is not divided into plural light beams. Instead there are plural light sources each emitting one beam.

Regarding claim 13:

Besides being dependent on claim 12, this claim directly recites the “wave-distance-dividing module,” and so the Examiner’s assumption regarding the meaning of the word “distancing” is unnecessary. This claim is rejected for the same reasons as claim 1.

Additionally, this claim requires that the wave-distance-dividing module be capable of dividing a first plurality of light beams into a second plurality of light beams.

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No such functionality is disclosed. In the specification, the wave-distance-dividing module is only disclosed as dividing the light from a single source into a plurality of light beams.

Regarding claims 14-27 and 42:

These claims are dependent on claim 12; claims 16-18 are additionally dependent on claim 13, and so directly recite the "wave-distance-dividing module."

Regarding claims 28-36:

Claim 28 contains language similar to that of claim 12; claims 29-36 are dependent on claim 28; claims 29 and 30 additionally recite method language corresponding to that of claim 13.

Regarding claim 37:

The recited "means for distancing final light source into a plurality of light beams" is the wave-distance-dividing module, and so this claim is similarly rejected.

Regarding claims 38-41:

They are dependent on claim 37; they additionally recite method language corresponding to that of claim 13.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 12-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12:

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The claim recites "distancing the selected final light source into light beams." The word "distancing" means "to place at a distance" (see The American Heritage College Dictionary, Fourth Edition). This claim element therefore becomes "to place at a distance the selected final light source into light beams." This does not make any sense.

Judging from Applicant's disclosure, Applicant may mean to claim "dividing the light from the selected final light source into light beams," as per Fig. 8 of the specification. The Examiner has presumed this was the Applicant's intent for the purposes of most of the rejections in this Office Action.

However, Applicant may be trying to claim a separate embodiment: one as per Fig. 4, where there is a plurality of final light sources that are spaced a specific distance from one another. In this case, significant revision to the claim would be required to make it clear.

Regarding claims 13-27 and 42:

These claims are dependent on claim 12.

Regarding claims 28-36:

Claim 28 contains language similar to claim 12; claims 29-36 are dependent on claim 28.

Regarding claims 37-41:

Claim 37 contains language similar to claim 12; claims 38-41 are dependent on claim 37.

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10. Claims 37-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1:

This claim uses means plus function language, and so is being treated under 35 U.S.C. 112, sixth paragraph.

However, if one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an Applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. See *In re Donaldson Co.* and MPEP 2818.

Therefore, these claims fail to particularly point out and distinctly claim the invention because the disclosure is not adequate for the "means for distancing final light source into a plurality of light beams." One of ordinary skill in the art would not understand what structure would perform the recited function.

This is for two reasons. First, the disclosure does not use the term "distancing," and the word itself is confusing in this context, so it is not clear what function Applicant intends to claim. If Applicant, by "distancing," means "dividing," Applicant intends to claim the wave-distance-dividing module. However, if by "means for distancing final light source into a plurality of light beams," Applicant intends to claim "placing a plurality of light sources at a distance," Applicant is claiming something else entirely. The word

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“distancing” fails to associate the claimed means plus function to a particular structure, material, or act in the specification.

Second, presuming Applicant intends to claim the wave-distance-dividing module, since Applicant’s disclosure does not provide any details of the structure of this module, one of ordinary skill would not have known what structure performs the function recited in the means plus function limitation.

Regarding claims 38-41:

These claims are dependent on claim 37 and are rejected for the same reasons.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-7, 13-19, 25-33, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kosoburd et al. (US 2003/0206503).

Regarding claim 1:

Kosoburd discloses an optical storage medium reading device, comprising:

an optical storage module, having an optical storage medium therein (Fig. 1);

a light-switching module, for selecting a final light source according to the optical storage medium and projecting the one or more first light beams from the final light

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source outward (the module itself is not shown, but is inherent: paragraph 35 shows that the light source is selected based on the kind of disc, so a light-switching module is required; the light beam itself is shown in Fig. 1);

a wave-distance-dividing module, for dividing the one or more first light beams into one or more equidistant second light beams and projecting the one or more second light beams onto the optical storage medium (Fig. 1: 13 or 14; paragraph 36); and

an optical sensor module, for identifying data on the optical storage medium according to the light wave reflected from the optical storage medium inside the optical storage module (Fig. 1: 22; for example, paragraph 42).

Regarding claim 2:

In Kosoburd the wavelength of one of the final light sources is 650 nm (paragraph 35: Kosoburd specifically discloses 658 nm but 650 nm is within the acceptable range for a DVD source such as Kosoburd's).

Regarding claim 3:

In Kosoburd the wavelength of one of the final light sources is 780 nm (paragraph 35: Kosoburd specifically discloses 785 nm but 780 nm is within the acceptable range for a CD source such as Kosoburd's).

Regarding claim 4:

In Kosoburd the distance of separation of the light sources after the final light source is divided by the wave-distance-diving module is 0.74 μm (paragraphs 9 and 36).

Regarding claim 5:

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In Kosoburd the distance of separation of the light sources after the final light source is divided by the wave-distance-dividing module is $1.6\text{ }\mu\text{m}$ (paragraphs 9, 36).

Regarding claim 6:

In Kosoburd the device further comprises an alignment module for receiving light from the wave-distance-dividing module and projecting the light onto the optical storage medium (Fig. 1: 16).

Regarding claim 7:

In Kosoburd the device further comprises an alignment module for receiving light reflected from the optical storage medium and projecting the reflected light onto the optical sensor module (Fig. 1: 16).

Regarding claim 12:

Kosoburd discloses:

An apparatus (Fig. 1) comprising:

an optical storage reading module capable of reading more than one type of optical storage medium (paragraph 34);

an optical sensor module capable of identifying data on more than one type of optical storage medium (paragraphs 41-42); and

a light-switching module (for this rejection, the Examiner has grouped Fig. 1: 11, 12, 13, 14, and 15 of Kosoburd and the associated control mechanism into a "light-switching module") capable of:

selecting a final light source based at least in part on the type of optical storage medium being read (paragraph 35);

“distancing the select final light source into light beams” (the Examiner has presumes this means “dividing the light from the selected final light source into light beams.” In that case, Kosoburd disclosed this in paragraph 36); and projecting the light beams onto the optical storage medium (paragraph 38).

Regarding claim 13:

Wherein the light beams comprise a first plurality of light beams, Kosoburd further comprises:

a wave-distance-dividing module capable of dividing the first plurality of light beams into a second plurality of light beams and capable of projecting the second plurality of light beams onto the optical storage medium (paragraph 37: the beamsplitter reflects the light having the second wavelength, so it divides the first plurality of light beams into a second plurality of reflected light beams).

Regarding claims 14-19:

All elements positively recited have already been identified with respect to earlier claims. No further elaboration is necessary.

Regarding claim 25:

In Kosoburd the light-switching module comprises a plurality of point light sources (Fig. 1: there is source 11 and source 12).

Regarding claim 26:

In Kosoburd the light-switching module is capable of activating and/or deactivating one or more of the point light sources (it uses only one of the sources, depending on the kind of disc: paragraph 35).

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Regarding claim 27:

In Kosoburd the light-switching module is capable of activating one or more of the point light sources to emit light with a substantially specific wavelength (paragraph 35).

Regarding claims 28-31 and 36:

These are method claims corresponding to earlier apparatus claims and are met when the apparatus operates.

Regarding claim 32:

The method of Kosoburd further comprises focusing one or more light beams reflected from the optical storage medium being read (paragraph 41).

Regarding claim 33:

The method of Kosoburd further comprises magnifying one or more light beams reflected from the optical storage medium being read (paragraph 41).

Regarding claim 35:

The method of Kosoburd comprises adjusting a final light source and positioning the final light source according to data read from the optical storage medium (paragraph 44: it uses processed signals to control a servo to position the optical pickup).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 8, 10, 20, 22, 23, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosoburd in view of Ju et al. (US 6,064,637).

Kosoburd discloses an optical storage medium reading device as discussed above.

Kosoburd does not disclose (claim 8) “a plurality of spherical lenses for focusing the reflected light onto a plurality of optical sensor cells on the optical sensor module.”

Kosoburd also does not disclose (claim 10) “a plurality of concave lenses for magnifying light falling on the optical sensor module to an image that targets various optical sensor cells on the optical sensor module.”

However, Kosoburd does disclose (paragraph 41) that a plurality of lenses may be used as part of a focusing method. Kosoburd just calls them “microlenses,” but doesn’t describe them in detail.

Ju discloses (Fig. 2) that a concave lens and a spherical lens may be used together in a focusing method (column 2, lines 30-55). They are used to focus the reflected light onto an optical sensor cell in the optical sensor module and to magnify light falling on the optical sensor module to an image that targets various optical sensor cells.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Kosoburd a plurality of spherical lenses and a plurality of concave lenses for focusing and magnifying the light falling onto the optical sensor cells, as taught by Ju.

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The motivation would have been to implement the focusing method only generally described by Kosoburd.

Regarding claims 20, 22, 23 and 42:

All elements positively recited have already been identified with respect to earlier rejections. No further elaboration is necessary.

15. Claims 9, 11, 21, 24, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosoburd in view of Alon (US 5,729,512).

Kosoburd discloses an optical storage medium reading device as discussed above.

Kosoburd does not disclose "a micro-adjusting module for shifting the optical sensor module so that light reflected from the optical storage medium can focus accurately onto the optical sensor cells of the optical sensor module."

However, Kosoburd does note that there may be a magnification error, and discloses that US Patent 5,729,512 teaches a means to correct this error (paragraph 94).

In US Patent 5,729,512, Alon discloses a micro-adjusting module for shifting the optical sensor module so that light reflected from the optical storage medium can focus accurately onto the optical sensor cells of the optical sensor module (column 10, lines 10-30).

It would have been obvious to one of ordinary skill in the art to include in Kosoburd a micro-adjusting module for shifting the optical sensor module so that light

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reflected from the optical storage medium can focus accurately onto the optical sensor cells of the optical sensor module, as taught by Alon.

The motivation is provided directly by Kosoburd: Kosoburd specifically references Alon's method as a means of correcting the magnification error.

Regarding claim 11:

Kosoburd in view of Alon discloses wherein the light-switching module adjusts a type of final light source selected and the location of the light sources according to the signal from the micro-adjusting module (In paragraph 69, Kosoburd discloses that the type of final light source is selected based on signal from the signal from the multi-channel conditioning circuitry; also, the location of the light sources is inherently decided by the type of final light source, as illustrated in Fig. 1. In Kosoburd in view of Alon, the multi-channel conditioning circuitry is part of the micro-adjusting module, because the micro-adjusting module uses the multi-channel signals to decide how to adjust the sensor module).

Regarding claims 21, 24, and 34:

All elements positively recited have already been discussed with regards to earlier rejections. No further elaboration is necessary.

Response to Arguments

16. Applicant's arguments filed January 24th, 2007 have been fully considered but they are not persuasive.

Applicant argues with both the rejections under 35 USC 112 and the rejections under 35 USC 102 and 103. Applicant breaks these arguments into sections; for clarity, the Examiner will do the same.

17. Regarding the rejections under 35 USC 112:

Applicant puts forth two arguments in response to the rejection of claims 1-11 under 35 USC 112, first paragraph.

First, Applicant argues that there are several embodiments “capable of carrying out the function of distancing light beams.” Applicant argues that in one embodiment, “distancing light beams is accomplished by a light-switching module,” and that in another “a wave-distance-dividing module to distance light beams is described” (remarks: page 12).

Applicant then argues that the Examiner has overlooked the embodiment where this function is accomplished by the light-switching module (remarks: pages 12-13).

This argument is not persuasive because the claimed subject matter that the Examiner rejected as not being enabled is the “wave-distance-dividing module.” This module is specifically recited in the claim. Therefore, even if the light-switching module is capable of “distancing” light beams, it is irrelevant to the rejection of claims 1-11. The wave-distance-dividing module must still be enabled since it specifically is claimed.

Applicant then argues (remarks: page 13) that even if “some experimentation were called for, this, by itself does not amount to lack of enablement.” Applicant states that “detailed and laborious plans or blueprints” do not need to be expressly provided.

Applicant supports this argument by noting that “the mechanical and electrical arts” have previously been characterized as predictable, and concludes by quoting *In re Wands* to show that “some experimentation” does not preclude enablement.

This argument is not persuasive because it would require more than “some experimentation” for one of ordinary skill to make and/or use Applicant’s invention. As noted in the rejection above, the Examiner has weighed a number of the factors from *In re Wands* and concluded that the amount of experimentation required would be undue. Applicant has not addressed these factors. Furthermore, Applicant’s argument regarding predictability is not really relevant to the rejection because Applicant’s disclosure does not provide enough information for the predictability of the art to even come into play: Applicant does not provide more than the most cursory description of their invention. Finally, Applicant fails to specifically identify how this predictability would enable one of ordinary skill, with merely “some” experimentation, to make and/or use the wave-distance-dividing module claimed.

Finally, the Examiner notes that the Applicant does not provide any reason why newly added claims 12-42 would overcome the rejection under 35 USC 112. As noted in the rejection above, although these claims do not all specifically recite the “wave-distance-dividing module” by name, the claimed subject matter still requires the wave-distance-dividing module and therefore they are not enabled either.

18. Regarding the rejection of claims 1-7 under 35 USC 102 as anticipated by Kosoburd:

Applicant argues with the Examiner's contention that the "light-switching module" claimed is inherent to Kosoburd.

This argument is not persuasive because Kosoburd switches between two light sources, depending on the type of disc, as disclosed in paragraph 35. Since Kosoburd switches between two light sources, a light-switching module to control the switching is necessarily present in Kosoburd. The apparatus is not going to switch without some kind of control mechanism.

19. Third, regarding the rejection of claims 8-11 under 35 USC 103:

Applicant only cites the alleged "deficiency of Kosoburd" with regards to the light-switching module. Since this module is necessarily present in Kosoburd, this argument has not been found persuasive.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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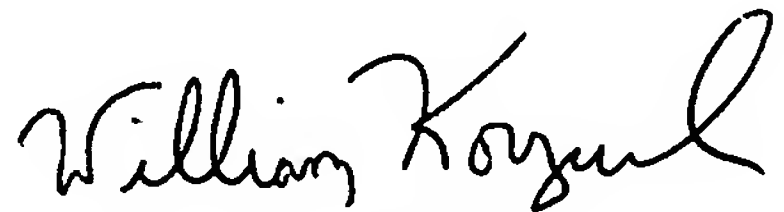
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lamb whose telephone number is (571) 272-5264. The examiner can normally be reached on 9:00 AM to 6:30 PM Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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